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Amdt. dated June 22, 2005
Reply to Office Action of March 23, 2005

AFTER FINAL EXPEDITED PROCEDURE
REMARKS

Claims 1 to 14 were pending in the application at the time of examination. Claims 1 to 14 stand rejected as obvious.

Applicant again calls to the Examiner's attention that responsibility for the above application has been transferred by the Assignee to the undersigned attorney. A Revocation of Attorney and Appointment of New Attorney has been filed and received by the USPTO. Please direct all future correspondence in the above application to the undersigned attorney.

Claim 7 is amended to address an antecedent basis informality. This amendment addresses an informality and so does not affect the patentability of the claim.

Claims 1, 6 to 8, 13, and 14 remain rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,112,049, hereinafter referred to as "Sonnenfeld," taken with U.S. Patent No. 6,418,466, hereinafter referred to as "Lection."

Applicant respectfully traverses the continued obviousness rejection of Claim 1. To make a prima facie obviousness rejection, the MPEP directs:

> **BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS**
> When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:
> (A) The claimed invention must be considered as a whole;
> (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
> (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
> (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141, 8th Ed., Rev. 2, p. 2100-120 (May 2004). It is noted that this directive stated "the following tenets . . .

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must be adhered to." Accordingly, failure to adhere to any one
of these tenets means that a prima facie obviousness rejection
has not been made.

The final rejection failed to adhere to multiple of these
tenets. As demonstrated more completely below, the claimed
invention has not been considered as a whole; the references
have not been considered as a whole; and the references do not
suggest the desirability of making the combination. Pieces of
the references have been extracted and selectively interpreted
in view of Applicant's claims. Also, the pieces selectively
extracted are from different functional levels, e.g., taking an
element at a code specific level and applying that element in a
completely different application at the user interface level.
Finally, there was no explanation of how the primary reference
would work for its intended purpose following the modification.

In the obviousness rejection of Claim 1, the original
rejection was repeated and then as a basis for maintaining the
rejection, the Examiner stated in part:

> Sonnenfeld is an automated testing system allowing
> design and administration of hierarchical testing scheme
> (col. 1, lines 56-58).

This general statement fails to teach anything concerning the
hierarchical testing scheme and is evidence that Sonnenfeld was
not considered as a whole to determine the type of hierarchical
testing scheme. A search of "hierarchical" in Sonnenfeld
showed that the heirachical testing scheme was:

> The "Interactive Testing System" ("ITS") uses the
> following conceptual hierarchical model:
> Test Administrator(s)->Test Designer(s)->Test(s)->
>   Section(s)->Question(s)->Choice(s)
> Test Administrators->Test Taker(s)
> Test Designer(s)->Test Taker(s)
> Test Part: Section->[Optional Break]->Section->[Optional
>   Break]-> . . . . .

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Sonnenfeld, Col. 5, lines 7 to 15.

> In summary, the "Interactive Testing System" uses the
> following conceptual hierarchical model:
> Administrator(s)->Designer(s)->Test(s)->Part(s)-
>   >Section(s)->Question(s)->Choice(s)

Sonnenfeld, Col. 15, lines 51 to 54.

Thus, "hierarchical testing scheme," when interpreted in
view of Sonnenfield taken as a whole, was a scheme that
included administrators, designers, tests, parts, sections,
questions, and choices. This high level description fails to
provide any detail of the relationships between the various
elements other than perhaps the relative level of the various
elements in the hierarchy, e.g., Administrators being at the
top and choices at the bottom. Nevertheless, the rejection
continued:

> The system provides a database of building blocks of
> the test (col. 3, lines 46-54) and wherein the building
> blocks can be grouped in various sequences to create a
> question and answer response system (on col. 2, lines 4 to
> 6).

Again, this quotation must be interpreted in view of
Sonnenfield as a whole, in particular, Sonnenfield defines both
the building blocks and the question and answer system.

First, with respect to the building blocks:

> The present invention overcomes the difficulties of
> the prior art by providing logical units (i.e., "building
> blocks") within an overall presented information stimulus,
> volitional response system. . . . Each building block is
> independent of the others and contains parameters that
> determine its functionality and implementation. . . .
> Each logical unit or "section" (also known as `building
> block`) has a set of parameters which define, for example,
> an interrelation of that section with other sections;
> grading instructions; adaptive aspects; allowable timing,
> sequencing and repetition; security; and randomization.

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Thus, the overall test structure is not required to define these aspects for each section of the test. . . . .

A section consists of one or more elements, being subject to the common parameter set. The element, in turn, may include any number of questions, i.e., zero or more. One or more sections may be grouped into a logical display set, termed a "part".

The test part, for example, is transmitted as a single logical unit from a server, which assembles each section, as necessary, based on the parameters, and then groups the sections, based on other parameters, as a part. The server then awaits receipt of responses, which are in a form defined by the section parameters, and interprets the responses in accordance with the section parameters, for output. The output may be subject to further analysis, such as individual and group statistics, feedback to the test taker, or the like. In this case, the server is not burdened with continual monitoring of each user, and thus may serve a large number of test takers simultaneously, without overload. The server is a transactional based device, servicing each test taker as needed to register, transmit a test part, and receive results.

Sonnenfeld, Col. 2, lines 1 to 45.

There are several important points. The building block cited in the rejection is also called a section by Sonnenfeld. A section is a defined group of elements and a common parameter set. The sections are grouped into a part that is manipulated by a server on the basis of the section parameters. The fact that the section can be grouped in various sequences teaches nothing concerning the specifics of the grouping and more importantly, nothing concerning information within a particular section such as the nodes recited in Claim 1.

The general overview statements used to justify the continued rejection demonstrate that the Applicant's claim language has been reduced to a gist, an improper form of analysis, and that the reference has not been considered as a whole. Applicant's claims do not recite a section in the abstract or a general hierarchical scheme.

Further, the rejection stated:

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teaches the user can indicate a number of sections to give for the text [Sic] and if the sections should be given out randomly;

Claim 1 recites nothing about indicating a number of sections to be given for the test or if the sections should be given out randomly. Thus, the gist of the invention has been rejected and not the specific claim limitations of Claim 1.

As noted above, a section and a building block in Sonnenfeld are the same unit and are at a higher level of abstraction than questions according to Sonnenfeld. Applicant's Claim 1 recites selecting nodes from within each of the sections defined in Claim 1.

Since the rejection addresses sections and not nodes associated with questions, the rejection fails to maintain a clear distinction between the definitions in the reference—the reference distinguishes between sections and questions—and the elements as defined within Claim 1 itself. This inconsistency is further evidence that neither Applicant's claims nor the prior art reference has been considered as a whole as required by the MPEP.

Next, the rejection stated:

furthermore the user can indicate a number of questions should be given out per section and can determine if the questions should be asked randomly

This two step sequence, as interpreted in the rejection, demonstrates yet further that Applicant's claim has been reduced to a gist. The rejection unambiguously stated "if the questions should be asked randomly." This means, the questions already have been selected and are being presented to the test taker in a random order. "[S]hould be <u>asked randomly</u>" fails to suggest or disclose

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randomly selecting a number of nodes from each of the
sections in said first DOM tree wherein said number of
nodes is said number for each of the sections

Selecting a number of nodes from each section randomly
where the questions associated with the nodes are used to
generate a particular set of questions in the question document
and an answer document as recited in Claim 1 is fundamentally
different from randomly asking a set of questions that has
already been selected, which is what was rejected. Thus, the
rejection itself demonstrates that a prima facie obviousness
rejection has not been made.

The rejection continues to mix and match terms and ignores
that definitions and distinctions made in the prior art
document and within Claim 1. Specifically, the rejection
continues:

> Further, Sonnenfeld does disclose "database of
> questions and answers", on col. 3, lines 46-52 teaches
> providing a database of building blocks of the test and
> col. 2, lines 4 to 6 teaches building blocks can grouped
> in various sequences to create a question and answer
> response system.

Claim 1 recites:

> refining said second DOM tree into a question
> document and an answer document

The second DOM tree was not based upon some arbitrary
sequence of building blocks, but follows directly from the
earlier parts of Claim 1. A question and answer response
system is not a question document and an answer document. The
rejection has not even alleged that such documents are
generated. Accordingly, this is yet another level at which a
prima facie rejection has not been made. The general overview
statement cited again reduces the claim to a gist and ignores
explicit claim limitations.

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It has been demonstrated that repeatedly, the gist of the claim language has been addressed in the rejection and not the specific claim language. The MPEP directs:

DISTILLING THE INVENTION DOWN TO A "GIST" OR "THRUST" OF AN INVENTION DISREGARDS "AS A WHOLE" REQUIREMENT

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole."

MPEP § 2141.02, Eighth Edition, Rev. 2, p. 2100-125, (May 2004)

The Examiner is reminded that the MPEP requires:

Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. (Emphasis in original.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-7, (May 2004).

The MPEP further requires:

Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation. The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. (Emphasis added.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-8, (May 2004). The above discussion of the rejection demonstrates that these requirements of the MPEP have not been followed with respect to claim interpretation and that explicit claim limitations have not been considered. These factors alone are enough to overcome the obviousness rejection.

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With respect to combining Lection with Sonnenfeld, the

final rejection stated:

> It would have been obvious to a person of ordinary
> skill in the art at the time the invention was made to
> have modified Lection into Sonnenfeld to provide a way to
> create a DOM tree and then make another separate DOM tree
> to restructure the data for output, as taught by Lection,
> incorporated into the question and answer data in HTML
> format as taught by Sonnfeld in order to easily and
> efficiently accommodate format changes of the data without
> having to modify the code each time the data changes.

This motivation is further evidence of an improper level

of analysis. First, Claim 1 has nothing to do with "easily and

efficiently accommodate format changes of the data without

having to modify the code each time the data changes." Thus,

the motivation is unrelated to Applicant's invention as recited

in Claim 1.

Also, even if Sonnenfeld were modified to incorporate DOM

trees to facilitate accommodating format changes of the data

without having to modify the code, the resulting combination

has nothing to do with Applicant's invention as recited in

Claim 1. Claim 1 recites nothing concerning using DOM trees to

accommodate format changes and modifying Sonnenfeld to include

such features has nothing to do with the question processing

described by Sonnenfeld and so teaches away from Applicant's

invention as recited in Claim 1.

Second, the rejection has failed to cite any teaching in

Sonnenfeld concerning data formats etc. or how the data in the

various sections of the test or the various interfaces are

managed. For example, the system of the secondary reference is

for "data from a dynamic schema, having dynamically variable

record formats." Lection Col. 2, lines 60-61. The rejection

fails to establish that Sonnenfeld utilizes "data from a

dynamic schema, having dynamically variable record formats."

Without such a showing, there would be no reason for one of

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skill in the art to use the teaching of Lection in Sonnenfeld, because the rejection has failed to demonstrate that the process of Lection would be useful in environments other than those described by Lection.

Nevertheless, the basis for continuing to use this motivation was:

> Sonnenfeld teaches a hierarchical testing scheme comprising of building blocks such as sections to create a question and answer response system . . . Further, Sonnenfeld teaches each section to be displayed by HTML and to be collected into a web page . . .

This has nothing to do with "in order to easily and efficiently accommodate format changes of the data without having to modify the code each time the data changes," which was the motivation given in the rejection. The reasons for maintaining use of the same motivation are logically inconsistent with the motivation itself. Second manipulating the HTML for display of a Web page via a DOM tree is totally at a different level than Claim 1.

The evidence continues to demonstrate that the Claims have been reduced to a gist, e.g., some DOM tree and not the specific DOM trees with the characteristics recited in Claim 1. In particular, the rejection continued

> Lection teaches the structure of an XML document is defined by the DOM tree; wherein DOM can be applied to both HTML and XML . . .

> Therefore, it would have been obvious [Sic] have modified Lection into Sonnenfeld to provide a DOM tree that defines the structure of the document, as taught by Lection , incorporated into the HTML document of Sonnefeld.

This motivation is unrelated to the motivation in the rejection of "in order to easily and efficiently accommodate

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format changes of the data without having to modify the code each time the data changes." Also, as defined by the rejection "the HTML document of Sonnefeld" is "each section to be displayed by HTML and to be collected into a web page." The fact that a section is displayed as a web page again has nothing to do with processing to obtain questions and answers for a question document and an answer document as recited in Claim 1.

The generalities used in the motivation concerning a DOM tree again are direct evidence that only the gist of the invention has been considered. The inconsistencies in the basis for the motivation, the inconsistencies in treating sections and building blocks as "nodes in DOM tree" where that nodes are not at the level of sections and building blocks demonstrate that neither the prior art references nor Applicant's Claim 1 have been considered as a whole. Applicant requests reconsideration and withdrawal of the obviousness rejection of Claim 1.

Claim 6 depends from Claim 1 and so distinguishes over the combination of references for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 6.

Claims 7, 8, and 14 stand rejected for the same reasons as Claim 1. Again, the combination of documents is unsupported by any teaching in either document, and further, if combined using the motivation relied upon by the Examiner, leads to an inconsistent interpretation. Consequently, the above comments with respect to Claim 1 are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 7, 8, and 14.

Claim 13 depends from Claim 8 and so distinguishes over the combination of references for at least the same reasons as Claim 8. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of Claim 13.

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Claims 2 to 5 and 9 to 12 stand rejected as being unpatentable over Sonnenfeld and Lection and further in view of U.S. Patent No. 6,519,617, hereinafter Wanderski. In the rejection of Claims 2 and 9, the rejection was repeated and stated in part:

> Wanderski does disclose "porting a document in XML format using DTD" on col. 2, lines 2-8 teaches when the user wishes to display a document formatted into XML the parser uses the DTD to determine how to process the XML document. The DTD is also applied with HTML and SGML (see col. 1, lines 26-col. 2, line 3.)

The basis given for continuing this rejection was:

> Wanderski teaches translating an input document into XML (See Abstract). Further, Wanderski teaches a document can be encoded into XML format (on Col. 2, lines 2-8).

This shows two factors, first Wanderski was not considered as a whole "An input document" in Wanderski was apparently interrupted as "any input document." However, Wanderski taught that the input document was a particular type of input document. Specifically,

> Three system components are involved in this modification. The first is referred to herein as a "translation engine", and is the subject of the first related invention. The second component is referred to herein as a "DTD generation engine", and is the subject of the present invention. The third component is referred to herein as a "transformation engine", and is the subject of the second related invention. The translation engine translates HTML to well-formed XML

Wanderski, Col. 7, lines 53 to 61.

> The translation engine is typically invoked in response to a user requesting a particular HTML document.

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Wanderski, Col. 8, lines 19 and 20.

Thus, when the Abstract of Wanderski is considered in view of Wanderski as a whole, as required by the MPEP, the input document is an HTML document and Wanderski is directed at the translation of such a document. The rejection has failed to cite any teaching in any of the three references of a word processing document.

In view of the fact that Wanderski describes that an HTML document is being translated, this portion of the rejection makes clear that the Examiner is relying upon Applicant's claim language and not any teaching or suggestion in Wanderski for the interpretation of what is translated. The MPEP directs that this is an improper form of analysis, specifically:

> Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

MPEP §2142, 8th Ed., Rev. 2, pg. 2100-128 (May 2004).

Wanderski, as quoted above, translated an HTML document and not a word processing document. Applicant notes that while the examiner is permitted to interpret claim limitations broadly, the MPEP puts specific bounds on such an interpretation. Specifically,

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

> During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification."

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MPEP § 2111 8th Ed. Rev. 2, p 2100-46 (May 2004).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.

MPEP § 2111 8th Ed. Rev. 2, p 2100-47 (May 2004).

**>Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art.

MPEP § 2111.01, II., 8th Ed. Rev. 2, p 2100-48 (May 2004).

Thus, Applicant respectfully submits that the interpretation used in the rejection of Claim 2 is neither related to Applicant's claim language nor related to the interpretation that would be used by those of skill in the art. The rejection has provided no basis for equating a HTML document to a word processing document and in fact, it is well known that the two types of documents are different.

The additional rationale provided for using the original motivation only further demonstrates an improper level of analysis. Specifically,

Therefore, it would have been obvious [Sic] have modified Wanderski into Sonnenfeld and Lection to provide a document encoded in XML format as taught by Wanderski, incorporated into the HTML document of Sonnenfeld and Lection.

Assuming this is all correct, it demonstrates that the combination fails to teach anything concerning a word processing document and the explicit claim limitations were not considered. The Examiner has rejected the gist of the Claim 2 and not the explicit claim language. Moreover, the combination is not well founded and even if the combination were correct, the additional information in Wanderski fails to correct the shortcomings of the primary references. Applicant requests

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reconsideration and withdrawal of the obviousness rejection of each of Claims 2 and 9.

With respect to the obviousness rejection of Claims 4 and 11, and Claims 5 and 12, Applicant respectfully submits that the combination is not well founded and even if the combination were correct, the additional information in Wanderski fails to correct the shortcomings of the primary references as discussed above with respect to the claims from which these claims depend. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 4, 5, 11 and 12.

Claims 1 to 14 remain in the application. Claim 7 has been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

Respectfully submitted,

CERTIFICATE OF TRANSMISSION
I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office, Fax No. (703) 872-9306, on June 22, 2005.

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Rivkah Young   June 22, 2005
Rivkah Young   Date of Signature

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